

REMARKS

In the May 24, 2005 Office Action, the Examiner:

- Objected to the Specification;
- Rejected claims 1-6 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;
- Rejected claim 4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; and
- Rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,069,616 (“*Doveinis*”) in view of U.S. Patent No. 6,295,762 (“*Nemoto*”).

Applicant amends claim 1 and cancels claims 2, 3, and 4. No new matter has been added. The pending claims are claims 1, 5, and 6.

Specification

Examiner has Objected to the Specification stating that the legal phraseology “means” should be avoided. Applicant has amended the abstract accordingly. In light of the above amendment, Applicant respectfully requests that the Examiner withdraw this objection. No new matter has been added.

Claim Rejections - 35 U.S.C. § 112

Examiner rejected claims 1-6 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement stating that the disclosure does not support the stop bar being non-elastic. Applicant respectfully disagrees with Examiner’s argument. A bar usually refers to a *non-elastic*, or *non-flexible* piece of wood or metal to one with ordinary skill in the art. Additionally, the American Heritage College Dictionary defines a bar as “a relatively long, straight, *rigid* piece of solid material used as a fastener, support, barrier, or structural or mechanical member.”¹ Furthermore, paragraph 16 states that “the stop bar 9 and the connecting slider 11 integrally and *linearly* slide from the glass rail 3 when the window ascends.” In order to be able to *linearly* slide, the stop bar must necessarily be rigid

¹ The American Heritage College Dictionary, p. 109, (3rd ed., 1997).

and non-elastic. Finally, the fact that the stop bar is non-elastic is illustrated in the drawings. For these reasons, Applicant respectfully requests withdrawal of this objection.

Examiner has also rejected claim 4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 1 by incorporating the limitations of claims 2, 3 and 4 and has canceled claims 2, 3, and 4.

The respective measurement is the distance of the location of the glass rail from when the window regulator is positioned such that the window is completely raised (see S3 in Figure 4) to the location of the glass rail when the window regulator is positioned such that the window is completely lowered (see S1 in Figure 4), and vice versa. The “maximum first distance measured downwardly from a straight line to the glass rail”² is illustrated as L2 in Figure 4 and the “maximum second distance measured upwardly from the straight line to the glass rail”³ is illustrated as L1 in Figure 4. The line is defined by the vertical movement of the glass rail, as depicted in Figure 4. This vertical line of measurement is formed perpendicular to the horizontal line that is formed by the glass rail.

In light of the above, Applicant respectfully requests withdrawal of this rejection.

Claim Rejections - 35 U.S.C. § 103

Examiner rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over *Doveinis* in view of *Nemoto*. Applicant, however, traverses this rejection in light of the amendments, for the Examiner has not established prima facie obviousness.

To establish a prima facie obviousness, the U.S. Patent and Trademark Office (“PTO”) must satisfy three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the reference teachings in the manner suggested by the PTO. Second, the skilled artisan, in light of the teachings of the prior art, must have a reasonable expectation that the modification or combination suggested by the PTO would be successful. Finally, the prior art reference, or references when combined, must teach or suggest each and every limitation of the claimed invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in

² Currently amended claim 1, line 15.

³ Currently amended claim 1, line 16.

the prior art, not in the Applicant's disclosure. If any one of these criteria is not met, prima facie obviousness is not established.

In *Nemoto*, base member 11 is not a non-elastic bar, as Examiner has stated, but a base member of the slider main portion 1. Additionally, member 2 is not a slider, as Examiner has stated, but a shaft portion of the slider main portion 1. Furthermore, member 21 is not a connecting element, as Examiner has stated, but a spherical head portion of the shaft portion 2.

Therefore, *Nemoto* does not teach or suggest each and every limitation of the claimed invention. In light of the above, it is respectfully submitted that Examiner has not established a prima facie case of obviousness. Applicant respectfully requests withdrawal of this rejection.


CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is now in a condition for allowance. However, should the Examiner believe that the claims are not in condition for allowance, the Applicant encourages the Examiner to call the undersigned attorney at (650) 843-4000 to set up an interview.

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order No. 060945-0139-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

Date: September 26, 2005

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